

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

TIVO INC.)(
(CIVIL DOCKET NO.
(2:15-CV-1503-JRG
VS.)(MARSHALL, TEXAS
(
(OCTOBER 24, 2016
SAMSUNG ELECTRONICS CO.,
(1:30 P.M.
LTD., ET AL.)(

CLAIM CONSTRUCTION HEARING

BEFORE THE HONORABLE JUDGE RODNEY GILSTRAP

UNITED STATES DISTRICT JUDGE

APPEARANCES:

FOR THE PLAINTIFF: (See Attorney Attendance Sheet docketed in
minutes of this hearing.)

FOR THE DEFENDANTS: (See Attorney Attendance Sheet docketed in
minutes of this hearing.)

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United States District Court
Eastern District of Texas
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(Proceedings recorded by mechanical stenography, transcript
produced on a CAT system.)

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1 COURT SECURITY OFFICER: All rise.

2 THE COURT: Be seated, please.

3 All right. This is the time for argument regarding
4 claim construction in the TiVo versus Samsung, et al., case.
5 This is Civil Case No. 2:15-CV-1503.

6 The Court will take announcements on the record at
7 this time.

8 What says the Plaintiff, TiVo?

9 MR. CHU: Good afternoon, Your Honor. Morgan Chu on
10 behalf of Plaintiff, TiVo, and at counsel table -- at the head
11 of counsel table is Sam Baxter from McKool Smith, and then
12 moving clockwise from Your Honor's left, Ben Yorks, Josh
13 Gordon, Ben Haber, Andrei Iancu.

14 MR. IANCU: Good afternoon.

15 MR. CHU: And we also have two representatives from
16 TiVo, Mike Schwartz and Matt Paik.

17 THE COURT: All right. Thank you, Mr. Chu.

18 What says Defendants?

19 MS. SMITH: Good afternoon, Your Honor. Melissa Smith
20 on behalf of Samsung. I am joined by Mr. Ruffin Cordell,
21 Mr. Thad Kodish, Mr. Noah Graubart, Mr. Chris Green, and
22 Mr. Karan Jhurani. Your Honor, we also have a few Samsung
23 representatives in the audience today. Mr. Dan Girdwood,
24 Ilsung Tak, and Ms. Sanglim Lee. And, Your Honor, we're ready
25 to proceed.

1 THE COURT: Thank you, Ms. Smith.

2 Counsel, the Court's aware that leading up to today,
3 there were briefed and submitted in this case something on the
4 order of 20 disputed terms for construction. My understanding,
5 based on meetings with counsel earlier today and emails that
6 have been exchanged, is that the parties are agreeing, with the
7 Court's approval, to present argument on five of the disputed
8 terms, with the remainder to be decided on the papers, those
9 five terms being input section, media switch, and media manager
10 from the TiVo asserted patents, and then channel
11 changer/channel selector and capable of displaying a user
12 interface from the Samsung patents.

13 Is that accurate?

14 MR. CHU: Yes, Your Honor.

15 MR. CORDELL: Yes, Your Honor.

16 THE COURT: Okay. Then unless there's some other
17 order that you believe is more compelling, we'll just take
18 argument on these five disputed terms in that order, beginning
19 with input section from the TiVo patents. And I'll hear from
20 TiVo first on this patent or this term.

21 MR. CHU: And may we approach to share slides with
22 Your Honor --

23 THE COURT: Yes, you have leave to distribute your
24 materials, both sides.

25 And, counsel, before you begin this particular term,

1 obviously, it was found in both the '389 patent, the '472, and
2 the '476. Would you agree that the issues are substantially
3 the same in all three, or are they distinguishable?

4 MR. IANCU: We do agree, Your Honor.

5 THE COURT: All right. Then let me have your argument
6 on this term when you're ready.

7 MR. IANCU: I am ready. Thank you, Your Honor.

8 Andrei Iancu on behalf of TiVo.

9 So as Your Honor has mentioned, the three patents,
10 '389, '472, and '476, are related, and we do believe that the
11 term, which is identical input section -- those words are
12 identical in the three patents -- should be treated the same
13 way.

14 And let's jump to Slide 38. We did distribute
15 notebooks, Your Honor, but in the interest of time, we're not
16 going to go through every slide. So we're going to jump around
17 a little bit. I will announce on the records which slide we
18 are going to go to. So --

19 THE COURT: That's fine.

20 MR. IANCU: -- beginning with --

21 THE COURT: That's fine.

22 MR. IANCU: Thank you.

23 Beginning with the input section, on Slide 39, we see
24 the two proposed constructions. TiVo's construction -- we
25 propose to be the same as this Court has construed in prior --

1 in the prior EchoStar case.

2 Samsung believes that this term is a
3 means-plus-function term.

4 On Slide 40, we see the Court's prior construction,
5 and the Court said, quote, the plain and ordinary meaning of an
6 input section is the portion of a device that receives inputs.

7 Your Honor, there is nothing new in this case, nothing
8 new in the intrinsic or extrinsic record to suggest that the
9 term should be changed. And the -- as a result, the same
10 constructions should apply.

11 Now, because of that, I want to shorten my
12 presentation and reserve most of my time for rebuttal, based on
13 what counsel says. Perhaps there won't be much to say, but
14 just briefly, if we could jump to Slide 42. Samsung says that
15 this is means-plus-function. It isn't. The word "means" does
16 not appear. There is a presumption as a result that Section
17 112 Paragraph 6 does not apply.

18 Sure enough, there are situations where the
19 presumption can be overcome. The Federal Circuit has said that
20 if we have generic terms, such as mechanism or element, things
21 like that, nonce words --

22 THE COURT: I'm familiar with the Williamson case.

23 MR. IANCU: The Court has said -- right. That's not
24 the case here. This Court, just earlier this year, and plenty
25 of other Courts have recognized a whole host of terms that do

1 not overcome the presumption.

2 Access point is an example from this Court earlier
3 this year. Here, input section tells us, as the Court
4 recognized in the EchoStar case, what the device is. It tells
5 us, in fact, where it is. It's at the input, the front end.
6 It tells us what it means to receive inputs. It's very much
7 unlike a module or an element where we don't know anything
8 about it other than the meaningless words, module, for example.
9 Here we know exactly what it is.

10 And as -- as I mentioned and as the Court has
11 recognized, the same term appears everywhere in the three
12 patents.

13 If we could go please to Slide 59.

14 The Federal Circuit has recognized in the past that
15 the same term should be interpreted the same way when it
16 appears in related claims. And as a result, we think the same
17 construction should apply in all of them, meaning the portion
18 of a device that receives inputs.

19 Unless the Court has questions, I will reserve my time
20 for rebuttal.

21 THE COURT: Let me hear argument from Samsung on this
22 term.

23 MR. GRAUBART: May I approach, Your Honor?

24 THE COURT: You may.

25 MR. GRAUBART: Thank you.

1 Good afternoon, Your Honor. Noah Graubart from Fish &
2 Richardson on behalf of the Samsung Defendants.

3 With respect to -- Mr. Jhurani, can you take us to the
4 first input section slide? Thank you.

5 As you noted, this term applied -- it appears in all
6 of the '472, '476 patent claims, as well as the so-called
7 hardware claims of the '389 patent. And as Mr. -- Mr. Iancu
8 said, under TiVo's primary construction, that is not 112(6),
9 they contend that the -- the construction should be the same.

10 The answer with respect to Samsung is slightly
11 different because as -- as the Court knows, we've proposed that
12 this be construed under Section 112(6), and although the
13 arguments as to whether the term is, in fact, governed by
14 112(6) are the same, regardless of which patent we're looking
15 at, once we've established that, then the question of what is
16 the corresponding structure, that differs. And the reason is
17 that both parties agree that if 112(6) applies, there are
18 different functions recited in the claims.

19 So once we've got different functions, we look to the
20 specification for the corresponding structures, and those, of
21 course, differ.

22 The term -- the disputes here are simply whether it's
23 a means-plus-function limitation, and if so, what's the correct
24 corresponding structure?

25 As Your Honor knows, in the Williamson case, we found

1 that the strong presumption doesn't apply, and the Federal
2 Circuit listed those examples of nonce words. One of them is
3 module.

4 Now, yes, this claim term is section, not module,
5 although TiVo's proposed construction is just portion. I'm not
6 sure whether -- how much that's different from module. But the
7 important point is that the specification here defines the
8 section as a module. It equates the claimed term section with
9 the nonce word that the Federal Circuit identified as module.

10 The specification points us to input section 101, and
11 when we look at Figures 1 and Figure 2, those are simply black
12 boxes labeled modules. So they're one and the same, and this
13 is merely a nonce word.

14 TiVo's own inventor -- and I -- we noted that this was
15 restricted AEO, but I understand TiVo's counsel has confirmed
16 they're okay with this being displayed on the screen. TiVo's
17 lead inventor, Mr. Barton, confirmed that this was not a known
18 term in the art. He -- the inventor simply slapped the terms
19 "input section" and "output section" on -- as arbitrary labels
20 on boxes that were collections of functionality. It was merely
21 a nonce term defined in term of its function.

22 TiVo, in support of its construction, relies on this
23 IEEE dictionary definition of the word "input." But itself
24 provides nothing more structurally. It says it's a device --
25 again, we know that's a nonce word -- and that it's used for

1 bringing data into another device, purely functional.

2 So TiVo then turns to relying on the Apple versus
3 Motorola case from the Federal Circuit where the Federal
4 Circuit did say -- it did find in that case that 112(6) did not
5 apply. And one of its reasons was it said that in -- the claim
6 at issue did reference the terms "inputs" and "outputs," and
7 that helped defined its structure.

8 But that was only one aspect of the Court's
9 conclusion. Yes, in some situations where you have a known
10 term that has its own structure, defining its inputs and
11 outputs can also connote additional structure. But the Court
12 has never found that -- the court -- the Federal Circuit has
13 never found that simply referencing some inputs and outputs
14 provides structure where the term itself has none.

15 And so when you look at the term that was actually at
16 issue in Apple/Motorola heuristic, the Federal Circuit said
17 that has a known meaning in the art that connotes structure to
18 a person of ordinary skill.

19 And in addition, we find that these inputs and outputs
20 confirm that.

21 And similarly, when we look at the Intellectual
22 Ventures II case that -- that counsel mentioned regarding
23 access point, Your Honor found that it had a definite -- it had
24 a known meaning that connoted definite structure to those of
25 skill in the art.

1 But when we're talking about section, which TiVo has
2 itself in its own patent defined as equated with module, which
3 the Federal Circuit tells us is a nonce word, there's no
4 structure.

5 Recently, in its reply brief, TiVo for the first time
6 raised additional extrinsic evidence that was not in its joint
7 claim construction statement and is, therefore, waived. But
8 even if we look at it, TiVo contends that these extrinsic
9 references from the early 1990s or late 1980s describe how --
10 how a person of ordinary skill in the art would understand
11 input section to have structure.

12 But you'll see that these references' discussion of
13 input section, they vary widely in terms of the structure that
14 it supposedly conveys to a person of ordinary skill. One is
15 another VCR, a camera, a microphone, an input filter, a
16 television receiver tuner.

17 And more importantly, none of those are linked to the
18 function that this claim needs to perform. Here it says that
19 it's an input section for converting an input signal into an
20 M -- MPEG stream for further processing. Well, if Your Honor
21 looks at this left-hand reference, the troubleshooting -- VCR
22 troubleshooting guide, it describes an input section as a
23 camera, a microphone, et cetera. And then right below it, it
24 references a recorder section. And that's what converts all
25 the input signals into a form for suitable saving, et cetera.

1 So the references on which TiVo rely here actually
2 confirm that a person of ordinary skill would not know input
3 section as a sufficiently definite structure for performing the
4 claimed function.

5 Mr. -- Professor Storer, TiVo's expert, I think his
6 opinion underscores also that TiVo's proposed construction of
7 just portion of a device that receives an input can't be right.
8 He says that, well, a person of ordinary skill would understand
9 that input section in the television field has a particular
10 meaning, such as the front end of a VCR or such as a television
11 receiver. Well, that -- that may or may not be true, but
12 that's certainly not what TiVo's construction is.

13 So they're telling Your Honor that a person of
14 ordinary skill finds definite structure in the television field
15 for receiving television broadcast with a television receiver,
16 and yet they're -- they -- they tell you that it should be
17 construed as just a portion of a device for receiving, purely
18 functional terms.

19 So now we've established that 112(6) applies. As the
20 Court knows, the next question is what is the corresponding
21 structure? The parties agree what the claimed function would
22 be, and as I said in the '389 patent, it's this conversion
23 step.

24 What is the corresponding structure? I think Your
25 Honor will find that the specification is pretty express here

1 on clearly linking that to either an MPEG encoder or an MPEG2
2 transport demultiplexor.

3 And why do I say either/or? It's because the
4 specification tells us that. It says that when you are
5 receiving -- when the system receives an analog input signal,
6 you're going to need an MPEG encoder.

7 TiVo -- nowhere in its briefing does it take issue
8 with that. There's no disagreement.

9 When we then turn to a digital input into the system,
10 the specification tells us precisely what to do, replace the
11 encoder and put in an MPEG2 transport demultiplexor and delete
12 the encoder.

13 So I'm not sure I could come up with a better example
14 of a clear linking from a specification telling us when I
15 perform X function, I take what the parties seem to agree as
16 one for -- in one scenario and I replace it with another. It's
17 express.

18 In contrast, the structures to which TiVo points,
19 first -- the first of them is a black box, input module 101.
20 That plainly does not convey any structure. There's no
21 specificity whatsoever.

22 And TiVo also said it includes a demodulator. There
23 is no demodulator in the '389 patent. They added it later in
24 new matter in 2001. But -- and TiVo's briefing says, well,
25 it's inherently there. That may or may not be true, but the

1 Federal Circuit both Atmel and the Biomedino case say that's
2 not sufficient. It needs to be physically present in the
3 specification. The patent needs to tell you what the structure
4 is and clearly link it to the function. So it can't be simply
5 black box 101 and a non-existent supposedly inherent
6 demodulator.

7 When we turn to the '472 and '476 patents, the claimed
8 functions differ from the '389. One of them is -- is fairly
9 similar, and that's the passing the input signal in '472 or
10 creating a transport stream function in '476. And for those,
11 we put forward the same arguments as to the MPEG encoder or
12 MPEG2 transport demultiplexor.

13 But it also adds -- the '472 and '476 claims, the
14 parties agree, add an additional function, and that's acquiring
15 an input section. And so what does the specification tell us
16 is the structure that requires the input signal? We agree here
17 that the answer is a demodulator. That -- that is present in
18 the new matter that was added in the '472 and '476.

19 And then TiVo says, well, it's also tuners 201 through
20 204. Those are, again, black boxes. These are not structures
21 that are defined there with just those -- those few words. So,
22 instead, what Samsung is pointing to is the specific
23 specification passages that describe those tuners, and they do
24 so similar to how Mr. Storer -- or Professor Storer described
25 the structure of input section. It is television tuners for

1 receiving television broadcast signals in various television
2 standards formats.

3 So if we're going to -- it can't simply be tuners 201
4 to 204. That tells us nothing. The specification describes
5 what it -- the structure actually is for performing this
6 function.

7 And with that, I think I'll sit down unless Your Honor
8 has any questions.

9 THE COURT: No, counsel. I think you're pretty clear
10 on your client's position.

11 Let me hear a response from Plaintiff.

12 MR. IANCU: So thank you, Your Honor.

13 First of all, module is not a claim element here.
14 This is input section. It's true, a figure does say input
15 module, but the claim limitation, which is what matters here.
16 And most of the places in the specification is input section,
17 and that is not a nonce word. That has been construed.

18 Now, even the word "module" is not always a nonce
19 word. Specifically, any word that Courts have identified as
20 nonce words sometimes are not nonce words, and the -- the
21 argument varies based on -- the construction varies based on
22 the specific -- the patents they appear in.

23 For example, the word "device" was construed in the
24 past as a nonce word by the Federal Circuit, but the Federal
25 Circuit has also said in the Inventio case that the phrase

1 "modernizing device," it's a very specific kind of a device, is
2 not a nonce word.

3 So here, not only do we not have module in the claim,
4 but it's clear that whatever it is, the input section itself is
5 a known thing. And as the Court said, it's the part of the
6 device that -- that accepts inputs.

7 The key here, Your Honor, for the construction in this
8 case is that there is nothing new in the record since the Court
9 construed the term in the first case. The -- for example, the
10 deposition testimony from Inventor Jim Barton they point to is
11 from 2005.

12 And the original Markman case, the reason the Court --
13 the Supreme Court said that claim construction is a matter of
14 law for Courts to decide is to impart uniformity and stability
15 to the meaning of claims in patents. So if we can vary the
16 same term from case to case in the same exact Court for the
17 same patent, especially when nothing really has changed in the
18 intrinsic record, the whole purpose of the Markman decision
19 from the Supreme Court is to a large extent vitiated.

20 THE COURT: Let me ask you this, counsel. You --
21 you've argued that 112(6) does not apply, and, of course, your
22 opponent has argued that it does. And then he's laid out for
23 me what he believes the function and structure would be in the
24 applicable claim language if the Court were to construe this
25 pursuant to Section 112(6).

1 I know it's your position, and I understand your
2 argument as to why that's not the case, but just so we have a
3 complete argument in the record, if the Court were to construe
4 this under 112(6), how do you differ from what your opposing
5 counsel's presented with regard to both function and structure?

6 MR. IANCU: So the biggest problem with their
7 construction is that they include a demultiplexor.

8 If we could go to Slide 51, please? I'll go get my
9 clicker.

10 And you see in the highlighted passages at 3:30 to
11 3:61 and 6:26 to 35, the demultiplexor appears as an example
12 excerpted at the bottom of Slide 51. And what is clear is that
13 the specification says this is a condition. If a digital
14 signal is being processed and you send interleaved signals, in
15 that case, you might add a demultiplexor. And the law is
16 crystal clear that the Court cannot import into the claim
17 features that are unnecessary to perform the claimed function.

18 And here the function is -- even -- even assuming that
19 this is a means-plus-function term, which, again, we don't
20 agree, but the function that Samsung articulates is converting
21 said specific program to an MPEG formatted stream for internal
22 transfer and manipulation. That is not what the demultiplexor
23 does.

24 The demultiplexor separates, demultiplexes the -- the
25 input stream that's being acquired. So not only isn't it

1 necessary, it doesn't even perform the -- the function at -- at
2 issue here.

3 THE COURT: All right. Anything else?

4 MR. IANCU: That's it on our side, Your Honor.

5 THE COURT: All right. Well, let's consider that that
6 concludes argument on input section.

7 And let's go next to media switch. Again, I
8 understand this is a TiVo term, so let me hear from TiVo on
9 this.

10 And let's start off, counsel, with the same question.
11 Do you agree that the issues here are the same across the
12 patents-in-suit, the '389, the '472, and the '476?

13 MR. HABER: Yes, Your Honor.

14 THE COURT: Okay.

15 MR. HABER: Benjamin Haber for TiVo. It is our --
16 TiVo's position that the "media switch" term should be
17 construed the same way in each of the patents.

18 THE COURT: All right. Let me hear your argument.

19 MR. HABER: And we have on Slide 91 just the patents.
20 And what you'll note is that the '389 patent and the '472 and
21 '476 patents are related. And the "media switch" term appears
22 in each of them.

23 And the "media switch" term itself, the smaller term,
24 "media switch," was construed by this Court in its EchoStar
25 decision as hardware and/or code that mediates between a

1 microprocessor, CPU, hard disk or storage device, and memory.
2 And it's TiVo's position that that construction should apply in
3 each of the three patents at issue.

4 As far as the smaller term goes, "media switch," the
5 parties substantially agree that that is the meaning of a -- of
6 a media switch.

7 Samsung seeks to import additional limitations into
8 the construction of media switch, specifically the parse and
9 separate limitations.

10 THE COURT: Haven't the parties agreed that parse
11 means analyze?

12 MR. HABER: Yes, the parties have agreed that parse
13 means analyze, and the parties have also agreed with regard to
14 the "separate" term in the '389 patent. And so there really is
15 not any dispute as to those terms.

16 Samsung, however, insists that media switch must be
17 understood in the context of the larger phrase in which it
18 appears in the '389 patent. We don't believe that that is
19 correct.

20 Media switch itself has its own definition that was
21 provided by this Court in EchoStar. That's what's stated --
22 what's stated here.

23 And if we go to the '389 patent -- I'm on Slide 95 --
24 you can see media switch appears there, as well. And then
25 there is an additional wherein clause that says: Wherein said

1 media switch parses said MPEG stream, said MPEG stream is
2 separated into its video and audio components. So parse and
3 separate are separately recited elements in Claim 31.

4 Now, if you look at Claim 1 of the '472 patent, for
5 example, the same term "media switch" appears, but the
6 limitations, parse and separate, do not appear in Claim 1 of
7 the '472 patent or in Claim 1 of the '476 patent.

8 And what Samsung is asking this Court to do is import
9 those limitations from Claim 1 of the '389 patent into Claim 1
10 of the '472 and '476 patents, which don't actually recite them.

11 Now, it's settled law that that is improper. You do
12 not import claim limitations from one claim into another when
13 that claim does not recite them.

14 So for that reason, it is TiVo's position that media
15 switch in each one of the patents should be given the same
16 construction, and that is the construction that was provided by
17 this Court in EchoStar.

18 Unless there are any questions, I will reserve time
19 for rebuttal.

20 THE COURT: All right. Let me hear a response from
21 Samsung.

22 MR. GRAUBART: Thank you, Your Honor.

23 And -- and in one sentence on input section, Mr. Iancu
24 said nothing had changed. Williamson v. Citrix has changed,
25 Your Honor. The law is different.

1 Turning to media switch, Mr. Jhurani. Thank you.

2 The disputed issue here is whether the media switch
3 performs parsing and separating in both -- excuse me, in all of
4 the '472, '476, and '389 patents. The parties do agree that it
5 should be construed consistently. And consistent with what
6 TiVo has repeatedly told this Court and the Federal Circuit,
7 the invention that TiVo filed its patent application on in 1998
8 was a media switch. It included a media switch that must
9 physically separate the video and audio components of the
10 stream.

11 Before I talk further about where the parties
12 disagree, I want to at least reiterate some areas that the --
13 the parties are in agreement.

14 So we see that the media switch is in the heart of the
15 invention here in Figure 1. You see it sits between multiple
16 components. And as TiVo will concede -- in some claims, at
17 least, TiVo agrees that it performs this physical separation.
18 A signal comes in, media switch parses it, and then separates
19 it out into its audio and video components.

20 Again, another area the parties agree is that this is
21 a -- a coined term, made up. It had no ordinary meaning to a
22 person of ordinary skill. Multiple inventors over and over
23 conceded readily that, yeah, this is something they coined.
24 As, of course, they're entitled to do. They act as their own
25 lexicographer. But we know that they're -- this has no plain

1 and ordinary meaning to a person of ordinary skill.

2 Samsung's expert agrees, but what's more important
3 that you don't see on this slide is TiVo's expert doesn't
4 disagree. There is no -- no expert opinion that this has some
5 sort of ordinary meaning in the art.

6 So as a result, we have to look to the specification
7 and understand what the specification -- how it defines this
8 term. That's what the Federal Circuit told us in the 3M
9 Innovative Properties case. And here it's pretty easy to know
10 what the specification tells us about this.

11 TiVo's told us over and over. Over and over, TiVo has
12 said this is not some tangential limitation in just some
13 dependent claims or something. This is the heart of the
14 invention. Mr. Chu, during opening statements in the EchoStar
15 trial, told the jury that this was the heart of the invention,
16 it was its brains and its brawns. And TiVo also takes the
17 position that in the '47 -- the '472 and '476 patents claim
18 priority to the '389 patent that was at issue there, that it's
19 the same invention. It also finds its disclosure in the 1998
20 invention.

21 And so all we're asking is that the Court hold TiVo to
22 its word, that the -- the invention, this media switch from the
23 1998 specification, is the thing that performs physical
24 separation of video and audio data.

25 As you see on this Slide 55, in TiVo's appellate

1 brief, they said it's in the heart of the device and the media
2 switch parses the MPEG stream which is separated into its video
3 and audio components. But much more forcefully, at oral --
4 oral argument, TiVo's appellate counsel, Seth Waxman, said --
5 and this is crucially important -- the media switch has two
6 functions, okay? One is that it parses said MPEG stream, and
7 the other is that the MPEG stream is separated into its video
8 and audio components. And Mr. Waxman went on to say that's the
9 genius. The core of this invention is the separation.

10 THE COURT: Mr. Waxman has not appeared in this case.

11 MR. GRAUBART: He has not, Your Honor.

12 THE COURT: Okay.

13 MR. GRAUBART: And all we're asking is that the Court
14 hold TiVo to its word in its statement to the Federal Circuit.
15 The Federal Circuit -- in that case, there was a dispute about
16 whether the separation needed to be physical or could only be
17 logical. And TiVo said that, well, there is one embodiment
18 where it's physical, but that's merely a preferred embodiment.
19 And that's Figure 3 here.

20 Well, the Federal Circuit looked at Figure 3 and said,
21 no, no, this is a required aspect of the invention. But not
22 just here in Figure 3. Again in Figure 4, the media switch at
23 the heart of the invention is described as operating the
24 video -- on video -- separate video and audio buffers.

25 The Court moved on to Figure 5. Once, again,

1 underscoring that the media switch separates the video, audio,
2 and private event data packets.

3 And then finally again in Figure 7, the Court said the
4 specification unambiguously describes the parser and the media
5 switch as doing this detecting, and then the -- the video and
6 audio components processed by the media switch are separated.

7 So at end of the day, the Federal Circuit looked at
8 TiVo's own statements and the patent's own statements and said
9 this is the invention. This is the present invention. And I
10 know Your Honor hears that argument a lot that, oh, the
11 specification says present invention, and we must limit it.
12 And admittedly, the Federal Circuit is a little hard to read on
13 whether -- when that matters or not.

14 Here, we already have the answer. The Federal Circuit
15 told us that in this patent, the phrase "the invention parsing
16 and separates by the media switch," that limits the invention
17 as a whole.

18 And, again, in this case actually TiVo has taken
19 positions that -- that further underscore that. Your Honor
20 might remember that we had one discovery dispute related to
21 whether TiVo would have to provide an interrogatory response
22 providing its written description support for its claim that
23 the '472 and '476 patents find priority in the original
24 specification. So once Your Honor compelled them, TiVo, for --
25 in the '472 and '476, you'll see that media switch has a bunch

1 of additional subcomponents that are recited. One of them is
2 this multimedia data stream processor.

3 What does TiVo rely on as support for the supposed
4 support in the '389 specification for that processor? That
5 very same "the invention" language that the Federal Circuit
6 told us requires the media switch to physically separate the
7 audio and video data.

8 So here, even in these additional claims, TiVo's
9 relying on the very same passage to tell us that the media
10 switch is described as performing this -- this separation.

11 TiVo says we're improperly importing from the '389 to
12 the '472 and '476. To the contrary, I'd say, Judge, it's not
13 Samsung that's telling you to do this. It's the patent. It's
14 TiVo's statements to the Federal Circuit. It's the Federal
15 Circuit finding about what media switch is. This is not an
16 importation. This is holding the patentee to its word and
17 using the consistent term "media switch" across all three
18 patents to have the meaning that the Federal Circuit found.

19 The SRI case was a very different situation involving
20 dependent claim limitations that the Court said shouldn't be
21 read up into the independent, and it doesn't apply here.

22 TiVo's last argument is that, see, there are some
23 claims that don't have anything to do with the separating and
24 parsing the so-called software claims of the '389 patent, but
25 those don't have any media switch at all. They are the

1 particular object-oriented software implementation, but
2 wherever there's a media switch, we know that that media switch
3 is defined as parsing and separating.

4 And very lastly, TiVo's construction is that this is
5 merely a -- an element in a hardware configuration that
6 mediates between various other elements. And if -- if Your
7 Honor looks at their infringement contentions, they -- TiVo
8 reads this on virtually any piece of hardware that receives
9 inputs and outputs data. Graphics processors, camera
10 processors, display subsystem processors. It's lost all
11 meaning whatsoever in TiVo's -- under TiVo's construction. And
12 when, in fact, they repeatedly told the Federal Circuit it's
13 the heart of the invention, and the Federal Circuit found that
14 that heart was separation.

15 THE COURT: All right.

16 MR. GRAUBART: Thank you, Judge.

17 THE COURT: Thank you, counsel.

18 A response from Plaintiff?

19 MR. HABER: Thank you, Your Honor.

20 A few quick points. The first was that the original
21 EchoStar trial involved the '389 patent which included claims
22 that had the -- this language in it, parse and separate. The
23 claims at issue here, the '472 and '476, don't have those claim
24 elements recited.

25 Additionally, the issue on the appeal in EchoStar was

1 not whether the media switch required a separating step. It
2 was whether or not separating, as recited in the '389 patent,
3 required physical separation or a logical separation.

4 Now, the appellate Court considering that issue found
5 that physical separation was required, as opposed to logical
6 separation, but it didn't hold that the media switch actually
7 had to perform separating.

8 And additionally, Samsung characterizes the
9 specification as stating that the media switch must separate.
10 But actually the specification is very clear, saying what the
11 media switch does. If you look at Column 3, Lines 62 through
12 65, it says: The media switch 102 mediates between a
13 microprocessor, CPU, hard disk or storage device, and memory,
14 period. And that is the construction that this Court applied
15 in EchoStar, and that is the construction that this Court
16 should apply here, as well, for all three patents.

17 THE COURT: All right. Thank you, counsel.

18 MR. HABER: Thank you, Your Honor.

19 THE COURT: Let's move on to media manager, and I'll
20 hear from TiVo on this term.

21 MR. HABER: I will stay here then. I'm going to be
22 talking about the "media manager" term.

23 If we could go to Slide 114.

24 So Samsung contends that the term "media manager" is
25 indefinite. The standard for indefiniteness is here on Slide

1 114.

2 What the Supreme Court held in Nautilus, claims are
3 not indefinite when claims viewed in light of the specification
4 and prosecution history inform those of skill in the art about
5 the scope of the invention with reasonable certainty.

6 Thank you.

7 Now, let's look at the claim. What the claim says is
8 that there is a media switch which comprises a media manager.
9 Pretty clear. The claim states that the media switch includes
10 a media manager.

11 Samsung argues that the claim is indefinite because
12 one of skill in the art would not understand that a media
13 switch can comprise a media manager. In view of the claims,
14 that argument does not hold water, and certainly they have not
15 provided clear and convincing evidence that one of skill in the
16 art would not understand the scope of this claim with
17 reasonable certainty.

18 Unless there are questions, I'll reserve time for
19 rebuttal.

20 THE COURT: I don't have any questions at this point.

21 Let me hear a response from Samsung.

22 MR. GRAUBART: Thank you, Judge.

23 Thank you.

24 So as -- as Mr. Haber said, this -- this term appears
25 in the '472 patent's independent claims. And I would agree

1 that if we look just solely at this language in isolation -- in
2 a vacuum, it is understandable. The claim says you have a
3 media switch, and that media switch comprises a media manager.
4 And then it tells us that that media manager has a host of
5 subcomponents like a DMA controller, host controller, et
6 cetera.

7 But the Federal Circuit in Phillips says we don't read
8 claims in their isolation. We need to read them and interpret
9 them in the context of the specification of which they're a
10 part. And when you look at the -- this patent as a whole, as
11 well as related patents, you'll find that a person of ordinary
12 skill would have no idea what is or is not a media manager.

13 And I'll show you why, Your Honor. First, we know
14 that the -- the '472 patent specification, the first 13
15 figures, these were all from the old matter that were filed in
16 1998. And they all are based on this architecture where the
17 media switch sits at the middle, in kind of a hub and spoke
18 kind of scenario where it's right in the data path between the
19 input and the output.

20 On the other hand, in 2001, TiVo filed a
21 continuation-in-part application that had also a very different
22 architecture, and that's this in Figures 14 through 22. First
23 of all, you'll notice there's no media switch here. Instead,
24 we have a media manager. And this media manager sits outside
25 that data path between the input and the output. And as a

1 result, TiVo's inventors explain that, yeah, it was a very
2 different architecture. You couldn't just simply replace the
3 media switch with the media manager, and they're -- they're
4 just very different components. It wouldn't have worked if you
5 had just switched it, they said.

6 And so the specification establishes that these are
7 mutually exclusive. TiVo says, well, they both are related.
8 They both perform mediation, and, therefore, the media manager
9 can just be part of the media switch. But that actually kind
10 of begs the question, well, why would we have two different
11 components in the same claim to perform this -- this exact
12 function? You wouldn't, in fact, because the specification
13 never describes such a scenario where you would have both. And
14 it wouldn't have made -- made any sense to it.

15 So what we have here as a claim -- as I said, does
16 make some sense on its face, but it stands completely at odds
17 and completely irreconcilable with the specification's
18 description of what a media manager is.

19 And in the Allen Engineering case where the Federal
20 Circuit considered a mechanical invention that had -- in the
21 specification, it said something could not pivot in a
22 perpendicular plane, and then the claim said must pivot in a
23 perpendicular plane, the Court said that's invalid as
24 indefinite under Section 112 Paragraph 2.

25 But there's also a second reason independent of that

1 contradictory position between the spec and the claims, and
2 that's that if you look at the juxtaposition of claims -- of
3 the claims in the '472 and the '476 patents, which are here on
4 Slide 74, the only real difference is that one of them has a
5 media manager. They both say you have a media switch,
6 including these four subcomponents.

7 And so how do we -- how is a person of ordinary skill
8 to know, particularly based in light of the -- the complete
9 contradiction with the specification, when there is a media
10 manager or when there isn't? It would leave a person
11 completely unsure as to what the scope of media manager is.

12 And, finally, just to underscore that, you know who
13 else is unsure about what a media manager covers? TiVo.
14 TiVo's position on what its products -- which of its products
15 are covered by the '472 patent, as opposed to the '476 patent,
16 which as I say, the only significant real difference there is
17 the -- the addition of a media manager in '472.

18 First they said, oh, yeah, all our products covered --
19 are covered by all the patents-in-suit. Six weeks later,
20 scratch that, not all of them, all of them but the Series 1.
21 Six weeks later, we throw up our hands and say we really just
22 don't have any idea. We can't say at this stage of the case.

23 And I don't see how construing media manager as simply
24 part of a media switch, which would have been TiVo's position
25 all along when it filed this lawsuit, would somehow leave it

1 able to figure this out. There's just no way to square it,
2 Your Honor. And for that reason, we ask that the Court hold
3 that the claims of the '472 patent are indefinite.

4 THE COURT: Let me confirm, counsel, that Samsung did
5 not supply an alternative construction in the event the Court
6 disagrees with you that it's not indefinite?

7 MR. GRAUBART: I think that's right, Your Honor.

8 THE COURT: You've -- you've hung your hat on that one
9 nail?

10 MR. GRAUBART: Yes, I have.

11 THE COURT: Okay.

12 MR. GRAUBART: Thank you.

13 THE COURT: Let me hear follow-up from TiVo.

14 MR. HABER: If you can go to Slide 107, please.

15 So Samsung is presenting an indefiniteness argument.
16 In an indefiniteness argument, you have to look at the claims,
17 you have to look at the scope of the claims. And here the
18 claims are very clear. The claim says: A media switch
19 comprising a media manager. The claims also tell us what the
20 media manager includes, host controller, DMA controller,
21 plus --

22 THE COURT: Slow down just a little bit, Mr. Haber.

23 MR. HABER: I apologize.

24 They tell us what the -- the media manager includes, a
25 host controller, DMA controller, bus arbiter, multimedia data

1 stream processor. And the specification also explains what the
2 media switch does, mediates, and further explains that the
3 media manager provides a number of functions, which is the
4 bridging and mediating functions, to a number of different
5 interfaces.

6 So what we have is a specific embodiment of the media
7 switch which includes a media manager for mediating and
8 providing certain components. And the claim is clear on its
9 face as to what that is.

10 Now, Samsung's argument about which products practice
11 the '472 and '476. The -- the reason that there were some
12 changes that were made were really about claim construction
13 disputes that have since been dropped. For example, there
14 were -- Samsung presented a -- a claim construction for
15 multimedia data stream processor, so the -- the scope of some
16 of these subsidiary terms was at issue, so TiVo was not willing
17 to say one way or the other under all the proposed claim
18 constructions as to practice of these terms. But Samsung has
19 subsequently dropped those constuc -- constructions, and -- and
20 there's really no question anymore.

21 So I think -- absent anything else, I think -- I think
22 we're concluded.

23 THE COURT: All right. Thank you.

24 All right. Let's go on to the first of the two
25 Samsung terms to be argued today, that being channel changer,

1 channel selector, from the '043 patent and the '333 patent.

2 Let me hear from Samsung on this term or terms.

3 MR. GREEN: Good afternoon, Your Honor. Christopher
4 Green for Samsung.

5 THE COURT: Good afternoon, counsel.

6 MR. GREEN: Thank you for having us here today.

7 THE COURT: My pleasure.

8 MR. GREEN: I'm sure there's nowhere else you'd rather
9 be right now. We'll make this as quick as we can.

10 Channel changer, graphical channel changer, channel
11 selector, graphical channel selector, all together, Your Honor,
12 from the two patents, '043 and '333 patent. And just for one
13 moment of context, the way that these patents made their way
14 into the -- into our collective consciousness, if you will, is
15 if you go back to 1996, when they were filed, you may remember
16 the old cable systems, you had maybe not as many channels as
17 you have now, but you had a lot of channels, and you'd have
18 this old scrolling guide, and so you'd have one channel you
19 could tune to, and it would be this kind of rolling -- like a
20 rolling credits kind of thing. And if it was on Channel No. 7
21 and you wanted to see what was on Channel No. 5, you had to
22 wait for Channel No. 5 to come back around.

23 So the improvement is this programming guide allowed
24 a -- an interactive experience. It allowed users to better
25 find and locate the channels that they want and then tune right

1 to the -- right to the Baylor game or the Texas game or the
2 Georgia Tech game, my -- my alma mater, or whatever it is you
3 want to watch, you don't have to wait for this whole guide to
4 scroll around.

5 So with that, let's jump right into the disputes. If
6 we go to Slide No. 10, excuse me. I'm battling Mr. Jhurani
7 here.

8 Here are the three disputes for the "graphical channel
9 changer" terms, Your Honor. The first is whether a graphical
10 channel changer is more than a mere list.

11 The next is whether the graphical channel changer is
12 required to be independent of an electronic program guide or --
13 or be any program-specific information, or whether that
14 programming guide -- I'm sorry, the graphical channel changer
15 can be part of and incorporated within the programming guide.

16 And then the -- the third dispute is whether the
17 graphical channel changer allows a user to select and tune to a
18 particular channel.

19 So let's jump right in, and let's start at the top
20 with the graphical user interface element. The plain language
21 of the claims themselves required the program guide to include
22 channel objects. You see Claims 1 and Claims 19 -- excuse me,
23 Your Honor, I'm going to pass those up. Thank you.

24 THE COURT: Go ahead.

25 MR. GREEN: Claims 1 and 19 -- and I'm looking at

1 Slide No. 11 of our presentation.

2 Channel objects are required to be part of the
3 graphical channel changer. And channel object is not a term
4 that you hear every day, but if we look on the next slide,
5 that's Slide No. 12, we see a description of what channel
6 objects are. A graphical channel changer, reading from the
7 excerpt on the top of the side, has a vertical channel bar that
8 includes graphical channel boxes. When Your Honor and your --
9 and your -- and your staff have read the patents, you've no
10 doubt come across this channel boxes term. That's the channel
11 object. Again, graphical elements that comprise the graphical
12 channel changer.

13 If we go to the next slide, Slide No. 13.

14 And what we see is we see some -- some additional
15 context. Here highlighted with a red rectangle and some blue
16 highlighting on the right side of the slide, we see some
17 familiar network call signs, ABC, NBC, CBS, Fox, Disney
18 channel. The blue boxes are those channel boxes or the channel
19 objects that are referenced in the claim. And they have things
20 like a channel name and a channel number. That allows a user
21 to -- to filter or sort in some ways, or at least know what it
22 is you're going to look at. And then the red rectangle that --
23 that surrounds it all, all of those things together make the
24 channel changer.

25 So what we have is a graphical channel changer

1 comprised of these -- these channel boxes or channel objects
2 using the language of the claim.

3 Now, let me step back, Your Honor. If I may, what we
4 see here is maybe the -- the confluence of our first dispute.
5 There is -- you could call this a list of information, but this
6 is not merely a list. It is some information about the
7 channels and their names and their numbers, but that's not all
8 that this is. It's not -- the term in the claim is not
9 graphical channel list. The term is graphical channel changer.

10 And let's look at that a little bit closer. So the
11 reason it's something more is because if we move on to Slide
12 No. 14, then we see we see a discussion of how an electronic
13 programming guide is based on the graphical channel changer.
14 And this is one of our other disputes.

15 TiVo suggests and argues that this graphical channel
16 changer must be independent of the programming guide. And I'm
17 not -- I'm not even sure how one would measure that, but it's
18 clear from the specification that that's not the case. The
19 electronic programming guide is based on the graphical channel
20 changer.

21 And if we step down to that second highlighting here
22 on Slide No. 14, we see in addition to the channel changer 800,
23 the programming guide 900 comprises. And we all know what the
24 word "comprises" means. It's one of those magic words in
25 patent law. So we see that the graphical channel changer is

1 part of the programming guide, not independent or separate from
2 it.

3 If we're looking for still more evidence that this
4 graphical channel changer is, in fact, part of the programming
5 guide -- and we can go to Slide 15. And we see two figures.
6 These are Figures 6 and 7 from the '333 patent. On the left
7 slide -- left side of Slide No. 15, we see the graphical
8 channel changer in isolation. And then on the right side, we
9 see the graphical channel changer as part of the programming
10 guide.

11 Now, you'll notice, because we've connected these
12 things up, every element that is in the graphical channel
13 changer, when shown in isolation, is also present in the
14 graphical -- I'm sorry, the electronic programming guide, the
15 channel bar, the channel changer itself, and all the channel
16 boxes that comprise the channel changer. There's no
17 separation. There's no need for logical, physical, or any
18 other kind of separation, Your Honor. These are one and the
19 same.

20 It's not just those figures. If we look at Figures 9
21 and 10 from that same '333 patent, then we see this same
22 concept. We see two big red rectangles, all which enclose a
23 graphical channel changer on the left side, some programming
24 information that's part of the larger programming guide.
25 Again, no logical separation, no physical separation, all one

1 and the same.

2 We step still further on to Slide 17, and this is just
3 a pause for a moment just to confirm that the '043 patent and
4 the '333 patent have the same disclosure. They -- they -- they
5 originated from a common provisional application. On that
6 right side of Slide 17, we see the familiar graphical channel
7 changer with the channel boxes.

8 And if I move on to the next slide, Slide 18, again,
9 we see the figures are virtually identical, and I think this
10 just reinforces why the parties have agreed all of these terms
11 from both patents, they need to have the same construction.

12 Again, we see that information in these graphical
13 channel changers, you could -- you could consider it to be a
14 list, if you wanted to, but it's not just a list. It's not
15 merely a list. It's part of something larger. So let's talk
16 about what that something larger is.

17 A big part of it is -- looking at Slide No. 19 -- the
18 ability to select and tune to a channel. This comes from the
19 plain language of the claim. The graphical channel changers or
20 the channel changer in this instance enables a user to select a
21 TV channel. And we're not going to select it just -- just for
22 the heck of it. We're going to select it for viewing.

23 If we move on to Slide 20, then we see that the
24 specification is going to tell us that a graphical channel
25 changer is for this exact purpose, selecting and tuning. The

1 top excerpt on Slide No. 20 says: The graphics on the TV set
2 may represent a graphical channel changer that enable a user to
3 select TV channels. But we don't stop there.

4 If we go to the bottom excerpts, we see that when a
5 user hits a select button on a remote control, then the central
6 processing unit in this television system is going to send a
7 command, a tune command to an RF tuner, and it's going to tune,
8 in this case, a satellite receiver -- doesn't have to be a
9 satellite receiver, but it's going to tune a satellite receiver
10 to a required TV channel. So we're not stopping with just the
11 act of highlighting or selecting. We're actually impacting the
12 operation of the circuitry and the hardware in this system to
13 cause the tuning -- the selection and tuning of a television
14 channel.

15 THE COURT: A minute ago you used the phrase, "we're
16 not just going to select it, we're going to select it for
17 viewing." Is selecting for viewing the same thing as tuning?

18 MR. GREEN: I would argue, Your Honor, that unless the
19 channel you select happens to be the one that the television is
20 already tuned to, then there will be a tuning operation,
21 because -- and if you have a system that's receiving more than
22 one channel, then selecting a channel or selecting a program is
23 going to require you to identify the signals that carry the
24 audio and the video and anything else goes with rendering the
25 images of that program on the screen. So you're going to have

1 to impact and cause the circuitry of the system to extract,
2 obtain, whatever verb you would like to use, that information
3 and cause that program to be available to the user.

4 THE COURT: So selecting for viewing as used a minute
5 ago is not the same thing as tuning.

6 MR. GREEN: I did not mean -- oh, selecting is not --
7 selecting is not the same thing as tuning. Those are not
8 redundant terms.

9 THE COURT: I understand that, but you said a minute
10 ago, we're going to select that, and we're not just going to
11 select it, we're going to select it for viewing.

12 MR. GREEN: That's correct.

13 THE COURT: And I thought you meant you'd crossed the
14 line between selecting and tuning when you said that, but I'm
15 trying to make sure whether you meant that or not.

16 MR. GREEN: I -- I mean to say that if you select for
17 viewing, it's the same thing as tuning.

18 THE COURT: Okay.

19 MR. GREEN: Thank you for that, Your Honor.

20 If I move on to the next slide, Your Honor, then we
21 have made it to the -- I guess the -- not the lowest, but a
22 third rung of the intrinsic evidence record. It's never really
23 been in doubt. It's never been contrary to the patentee's
24 intentions that these '333 and '043 patents were intended to
25 select and tune. Here we see a brief discussion of a prior art

1 reference called the Miller reference. It was cited against
2 the '333 patent in prosecution. The distinction that was made
3 to overcome the Miller reference, as shown in the highlighting,
4 is that the Miller reference did not function to change the
5 channel to the desired station.

6 So, again, selecting by itself wouldn't get you all
7 the way to -- to changing a channel. That requires a tuning
8 operation.

9 I have some additional points to be made. Maybe I'm
10 making them in the abstract, given that we haven't heard from
11 our colleagues at the other table yet, but this may be worth
12 just going ahead and preempting then.

13 The first is, Your Honor, I've mentioned several
14 times. These graphical channel changers are not merely a list.
15 I believe that is a litigation driven position. I get it. We
16 all do these kinds of things. But here, I believe it's
17 incorrect. It's intended to bolster TiVo's pending 101 motion,
18 but -- but these graphical channel changers are not just lists.

19 If we look to the -- the second bullet, we see that
20 TiVo itself is going to acknowledge that a channel changer is
21 intended to be part of a -- a graphical user interface. So
22 that gets us a little bit further down the road to the -- to
23 the correctness of Samsung's construction -- construction,
24 rather.

25 And the third point is that the channel changer, just

1 because it includes a list, doesn't mean it's going to be a
2 list. We see from the excerpt that the graphical channel
3 changer 800 allows the user to include any combination of TV
4 channels into a channel list to be displayed. But that's not
5 all the channel changer does. So we're not trying to run away
6 from the fact that you can list information in that channel
7 changer. We are saying that's an incomplete recitation of what
8 a channel changer is.

9 THE COURT: All right. What else, counsel?

10 MR. GREEN: There's so much more, Your Honor.

11 THE COURT: We have so little time.

12 MR. GREEN: I know.

13 The -- the last piece is we -- we were accused -- and
14 I'll say unfairly -- of having a construction that is
15 unbounded. It's not. Just because we have the term "graphical
16 user interface element," that doesn't mean we're trying to read
17 this on any -- any element of the graphical user interface. We
18 are speaking specifically to a channel changer that is
19 constructed from channel objects. The channel objects have
20 channel name, channel number information, and then we have the
21 selecting and tuning operation, so there is specificity here.
22 This is not one of those situations where the construction is
23 maybe worse than the original claim language or at least no
24 more certain.

25 And with that, Your Honor, I'll sit down and reserve

1 the balance of any time that we have, precious little though it
2 may be, for rebuttal.

3 THE COURT: All right.

4 MR. GREEN: Thank you.

5 THE COURT: Let me hear from TiVo in response.

6 MR. GORDON: Good afternoon, Your Honor. Josh Gordon
7 for TiVo.

8 THE COURT: Proceed, Mr. Gordon.

9 MR. GORDON: Thank you.

10 If we could go to Slide 3 of the...

11 So, Your Honor, because this term has not been
12 construed before, indeed these patents have never been at issue
13 before, it makes sense to step back a few feet and talk briefly
14 about the purpose for these patents as stated by the patentee
15 in the specification.

16 These two patents are related, as counsel informed you
17 previously. They also, as he informed you, share a common
18 priority to a provisional application filed August of 1996.

19 The '043 patent generally covers customizing, what we
20 call a list of TV channels. I'll get into that.

21 The '333 patent covers sorting those list of TV
22 channels.

23 These patents addressed very specific perceived
24 problems in the art, and the patentees acknowledged that the
25 art contained related functionality, including electronic

1 program guides. And they noted that in a conventional TV GUI,
2 graphical user interface, substantial time and effort to
3 require a customized list of channels. And also noted a
4 perceived problem that if you customize a list of channels, you
5 might end up with a format on the screen that's different than
6 where you were before.

7 They thought that was a problem, and they decided to
8 fix -- fix that specific problem with this claimed channel
9 changer. And how they did that was they claimed a regular
10 channel changer in which the user could see all the available
11 channels and a customized channel changer in which the user
12 could see a subset, a selected list, presumably smaller than
13 all the available channels. And the idea that these two
14 channel changers have the same configuration, so the user is
15 not confused once they go from all the channels to a subset of
16 channels.

17 With the '333 patent, they noted that there are TV
18 guides. And TV guides present a list of available channels and
19 programs that may be displayed on a TV screen. And those
20 channels are typically arranged in the order of number, as we
21 usually see when we pull up a TV guide. They thought it would
22 be desirable to sort these differently so that the user might
23 access the channel more quickly. And so they thought it would
24 be usable -- be convenient to present them in a manner more
25 easily searched and desired -- obtained the desired programming

1 promptly.

2 So to fix -- fix that specific perceived problem, they
3 came up with using the channel changer in a different mode.
4 Same channel changer using in a different mode to sort of the
5 channels in different -- in different ways, such as prescribed
6 order based on a name. Very specific problems in the art, very
7 specific solutions.

8 To do that, they came up with this common channel
9 changer. We've agreed, counsel has agreed that the definition
10 of this term applies for these patents.

11 On the left, you've got the '043 patent, Figure 6, the
12 channel changer 800 marked in red. And the '333 patent, Figure
13 6. Same figure. Counsel put up very similar -- similar
14 figures before. We don't have an argument that these figures
15 depict the channel changer in both patents.

16 In the '043 patent, it depicts, again, what we call
17 this list of channels -- the regular channel changer on the
18 left, customized channel changer on the right.

19 In the '333 patent, they depict this very same channel
20 changer, again, marked with 800. You can see the 800 channel
21 changer right under the top red -- top horizontal line of the
22 red box -- in various ways to sort the channel changer, such as
23 channel name, channel number, and program name.

24 So we do have significant differences in our
25 construction on this term. TiVo's on the left, a list of TV

1 channels from which a TV channel may be selected that a user
2 may access and navigate independent of an electronic program
3 guide or any program-specific information.

4 So there are three components to this, and I think
5 I'll take them in turn. The first one, which counsel
6 referenced, is that a user may access and navigate the channel
7 changer independent of any electronic program guide or
8 program-specific information.

9 So counsel noted the provisional application from
10 1996. He also noted incorrectly, I believe, that in 1996, as
11 of that date, the only available guides to people were what he
12 call the rolling screen, so you had to wait for the screen --
13 the channel you wanted to come back around.

14 THE COURT: I remember those.

15 MR. GORDON: I believe that -- I remember those, too,
16 but those predated 1996. In fact, they predated 1993. As of
17 1993, the familiar grid-like guide had been introduced. And as
18 of this 1996 provisional disclosure, the patentees understood
19 this. And they stated specifically -- and this is from the
20 '904 application, the August 1996 provisional application to
21 which both of these patents claim priority. It was taken right
22 from the patentee's language, and in this -- in this
23 application, I should note, there's an invention disclosure.
24 It's not just an application like you typically see filed at
25 the Patent Office. There are many pages of a Samsung document

1 incorporated into that provisional which is in the -- the
2 invention disclosure written by the -- the inventors.

3 And they say: The state of the art for graphical user
4 interface for television is electronic program art. Much prior
5 art is available showing a two-dimensional array of items that
6 show the channels listed vertically and the time listed in the
7 horizontal direction. And they include this Figure 11 to
8 reflect what they understood -- this is a program guide. This
9 was not novel. Much prior art is available showing this, they
10 noted.

11 The novelty of their invention -- and this is stated
12 by the inventors themselves in the provisional application --
13 the novelty of this invention is to, and I quote, break the
14 electronic program guide into two distinct functional modes.

15 And we've inserted a red line on the program guide
16 from that application to show how the inventors, quote, broke
17 the electronic program guide into two distinct functional
18 modes.

19 Mode 1, the channel changer. This is the term at
20 issue here in this case. Mode 1 is what we call, in quotes,
21 channel changer and is shown in Figure 10. The left-hand side
22 of the screen contains a list of channel logos and various
23 scroll bars, and you can see this image from the provisional
24 application, Figure 10, quote, channel changer, just shows the
25 list of channels in vertical order. This is the exact same

1 figure with minor non-pertinent changes that's depicted in the
2 '043 patent and the '333 patent in Figure 6.

3 THE COURT: They're showing just the name and the
4 number?

5 MR. GORDON: Just the name and the number. And as you
6 can see, they said -- in their words -- Figure 10 shows a
7 display in which the left-hand side of the screen contains a
8 list of channel logos and various scroll bars. No discussion
9 or depiction of program information. Channels only.

10 Mode 2, they said we're going to break it into two
11 distinct functional nodes. That was Mode 1. This is Mode 2.
12 Mode 2, they wrote, is the traditional electronic program
13 guide. However, unlike traditional systems, the EPG on the
14 Samsung GUI, graphical user interface, grows out of the channel
15 changer. So they said by this, we mean that the two-dimension
16 program time period appears instantaneously aligned with the
17 graphics for the channel changer.

18 So what they were trying to do is have a channel
19 changer that you could see the channels that you wanted, and
20 then once you access that and once you defined the parameters
21 of that -- for example, with the channels that you wanted to
22 see in the customized list -- then you take action. And when
23 you take action, the EPG on the GUI grows out of the channel
24 changer. And we've animated that to show that it grows out of
25 the channel changer -- the channels that you have on the

1 channel changer to the guide.

2 And as they said, this provides a very intuitive and
3 novel method for the user to quickly and seamlessly go from
4 channel changer mode to the EPG and still maintain contact.

5 THE COURT: I see where the channel changer might not
6 necessarily include programming information, but is there a
7 clear disclaimer where it says it can't?

8 MR. GORDON: That it cannot include program
9 information? No, Your Honor.

10 THE COURT: It must be just the name and number, as
11 you showed me to begin with?

12 MR. GORDON: No, Your Honor. And we don't contend
13 that it cannot be attached to a program guide as the inventors
14 stated here. Once you're in this Mode 2, and we -- we agree,
15 as is reflected in the '333 patent which -- which claims a
16 programming guide including a channel changer, it can be. The
17 two can be attached. The channel changer on the left, the bar,
18 the vertical bar, and the program guide -- program information
19 next to it. They can be attached to each other. But that's
20 Mode 2.

21 The inventor specifically said, you know, the novelty
22 of our invention is not just to have the guide, which they
23 admitted was in the prior art, but to have the channel changer
24 that can then transition to an electric program guide. So,
25 yes, they can be -- the two can be together.

1 Our position is just that they must be able to also be
2 separate, not that they can never be together.

3 And --

4 THE COURT: Well, is it your construction that they
5 must always be separate? Not that they can be?

6 MR. GORDON: That they may be. Perhaps may was used
7 inartfully, but they can be.

8 THE COURT: Okay.

9 MR. GORDON: And back to the transition reflected
10 in -- in the provisional application, Your Honor. The
11 inventors expressly said that user action was required for a
12 transition from the Mode 1 channel changer to Mode 2 program
13 guide. And they give a few examples of this type of user
14 action.

15 We've highlighted one here. They said you can click
16 this guide button or put your cursor somewhere on the screen,
17 and when you took that action, you could go from Mode 1 to Mode
18 2. And this is a quote from the same specification: In order
19 for the user to get from Mode 1 to Mode 2, the user had to take
20 some action. They included this -- this flowchart. As you can
21 see, is the user over the guide button? Yes. We're going to
22 change the color. And then, yes, we're going to transition
23 state to program guide. No? See if something else is
24 happening, in which the user might have indicated we're going
25 to go from Mode 1 to Mode 2.

1 If the two components could never be separate, this
2 transition could never occur. We must have some distinction
3 for the user to be able to go from 1 to 2 as initially
4 conceived by the inventors.

5 The claims in the specific -- specification are
6 consistent with this -- the inventor's intent to break the
7 electronic program guide into these two functional modes. They
8 carry this idea throughout.

9 THE COURT: If you don't mind, counsel --

10 MR. GORDON: Sure.

11 THE COURT: -- it's a little hard for me to pick up
12 some of the ends of your sentences. You're trailing off. If
13 you could be a little clearer as you finish your sentences.

14 MR. GORDON: I will actually do that. Would you like
15 me to go back to the beginning?

16 THE COURT: No, I would not. That part's clear.

17 MR. GORDON: That part is clear. I will try to do
18 better, Your Honor. Thank you for that. I appreciate that.

19 So, as I said, the inventors carried this idea through
20 the '043 and the; '333 patents, as well as a third patent that
21 we reference in our briefing that also claims priority to the
22 same provisional which is incorporated by reference into both
23 specifications, the '043 and '333, same family, '781 patent.
24 I'll talk briefly about that, as well.

25 As you can see, '043 Claim 1, there's no reference to

1 an electronic programming guide here. There's also no
2 reference to any program information. It only references TV
3 channels. Regular channel changer enabling a user to select a
4 TV channel among all the TV channels. Nothing but programs.

5 The '333 patent does talk about program guide. And
6 we -- the writing is there. We don't dispute that. They claim
7 a program guide, including a channel changer, which, again, is
8 consistent with this idea the channel changer is the bar on the
9 left and the two are together. The guide includes the channel
10 changer on the left.

11 However, the specification and the figures of the
12 '33 -- '333 patent adhere to the same construct, the same idea
13 that the two elements must be able to exist independently, not
14 that they must always be independent, but that they must be
15 able to exist independently.

16 For example, these two figures, Figure 6 and 7, are
17 from -- both from the '333 patent that claims the guide,
18 including the channel changer. It also has the same Figure 6
19 with just the channel changer on the left, and it has Figure 7
20 that counsel showed you, I believe, with the two of them
21 together. And by the two of them, I mean the channel changer
22 with program information to form the guide.

23 Language from both patents supports this idea --
24 supports TiVo's construction. On the left, when the user
25 directs the remote pointing device at a graphical button guide,

1 the button I showed you, the circular button I highlighted
2 previously, the TV GUI switches into program guide mode to show
3 TV programming carried by channels included in the currently
4 selected channel list.

5 So the user has customized a list to make it smaller,
6 a subset of all available channels, and then takes some action
7 in the guide that appears showing the programs appearing on the
8 channels included in the currently selected channel list.

9 Same -- same concept on the right. Don't need to
10 belabor it to death. When the user directs the remote pointing
11 device, again, the -- the channel changer is transformed into
12 an electronic program guide.

13 And, again, the program guide is formed out of.
14 Counsel talked about it's based on -- it's based on in the
15 sense that you have the one and then you can have the other.

16 This is the '781 patent I mentioned. This transition
17 that I've been talking about is claimed expressly in the '781
18 patent. Also claims priority to the same application. And
19 this -- the application for this related patent is incorporated
20 by reference into the '043 and '333 specifications.

21 And this patent clearly claims a graphical channel
22 changer, same term, and a facilitated transition for displaying
23 in the second mode an electronic TV program guide including
24 said graphical options. That is including what the channel
25 changer has presented.

1 And, again, the channel changer instantaneously and
2 directly transforms into that program guide. And, again,
3 without the possibility that the two elements can be separate,
4 there can be no transformation from one to the next. And this,
5 again, language from the '781 patent. Again, these two
6 figures, both from that patent, showing Figure 6, just the
7 changer, Figure 7 with the guide.

8 Now, Samsung's focusing on the '333 patent. And their
9 response to TiVo's arguments about the '904 application, they
10 don't deny the relevance of that application, nor could they.
11 They just say, well, it clearly teaches that they are -- the
12 channel changer and the guide are together. But they focus on
13 Mode 2. And they've quoted in their -- their brief language
14 that focuses on Mode 2. They forget Mode 1 where the novelty
15 of the invention was to break the guide apart, and Mode 1 is
16 just the quoted channel changer.

17 I'm just going to go a little more quickly to speed
18 this up. We've seen some of these slides before.

19 I want to talk also about the list point that counsel
20 raised. He said that it's not a mere list. It includes other
21 elements. We don't dispute that. Of course it's not a mere
22 list. But looking at the claim language -- and just go back to
23 the claim language for a second -- the claim is a television
24 system comprising a CPU, a TV monitor for displaying this
25 channel changer for enabling the user to select the TV channel

1 among all the TV channels. The fact that the channel changer
2 is not a mere list is embedded and included within the claim
3 language itself.

4 Our position is that if we're going to clearly define
5 what this is in the context of that claim language, then it's
6 accurately defined and described as a list of TV channels.
7 We're not saying it can't do anything with those channels.
8 Indeed, that's the point of the invention.

9 But if we're going to get some clarity to what this
10 is, our position that it is, in fact, a list of channels. And
11 that's not pulled out of thin air. That is based on the claims
12 and the specification and the prosecution history.

13 Here are the claims. This is Claim 1. It claims a
14 regular channel changer displaying all TV channels available.
15 A customized channel changer displaying a customized list of
16 the TV channels. And because the customized list has the same
17 configuration as the regular channel changer, it would make no
18 sense for the regular channel changer to be anything other than
19 in list form. Two configurations have to be the same. The
20 patents says customized list -- customized channel changer is a
21 customized list. It uses that language. If the two
22 configurations are the same, they both just must be in list
23 form.

24 This is how they've consistently depicted it from the
25 beginning of the invention, August 1996.

1 THE COURT: What else?

2 MR. GORDON: I'm sorry, Your Honor?

3 THE COURT: I was going to ask you what else you had.

4 MR. GORDON: Samsung's citation, opening brief, again,
5 in their papers, I think they've -- they've conceded this. The
6 position configuration operations of the channel changer
7 remains unchanged regardless of whether all channels or only
8 the customized list of TV channels is shown.

9 Again, '904 application, the patentees themselves --
10 inventors themselves described as a list of channel logos.

11 Now, before I get the -- the selection point, Your
12 Honor, I want to address very briefly this notion that --

13 THE COURT: Which notion?

14 MR. GORDON: Thank you, Your Honor. Appreciate your
15 patience for a minute.

16 The notion that Samsung's construction of a graphical
17 user interface element. And they've said that's not unbounded,
18 and that it's -- they said it's defined by having channel
19 objects. Well, I'm just going to get you to the right screen
20 so you can see the language I'm talking about, Your Honor, if
21 you'll bear with me for just a moment.

22 You can see on the right side -- it's faded, but
23 Samsung's construction is a graphical user interface element.
24 I'm not sure what that is, Your Honor. Is that broad enough to
25 cover the entire electronic program guide? Is it broad enough

1 to cover an Apple like Windows icon structure or a Windows
2 structure where you have different folders? Just because they
3 have this idea of a channel object doesn't mean that a
4 graphical user interface element is somehow not unbounded.

5 We are trying to define this with some clarity as to
6 the purpose of claim construction. We agree that this is in
7 the context of a graphical user interface. That's what the
8 patent says. It is a graphical user interface element. It has
9 certain functionality. But it would add ambiguity, not
10 clarity, to describe it as a graphical user interface element,
11 rather than what it is and how it's always been depicted, which
12 is a list of TV channels.

13 THE COURT: But the parties no longer dispute that
14 channel object is, in effect, the name and channel number; is
15 that correct?

16 MR. GORDON: So the parties have agreed on a
17 construction for channel object, and that is -- yes, Your
18 Honor, a selectable graphical user interface object that
19 depicts a channel name and channel number of a TV channel.

20 THE COURT: Okay.

21 MR. GORDON: And the last point, Your Honor, on
22 select. The claims use the language "select." I had the same
23 question you had. Our position is that select in the context
24 of this patent means that you change the channel. If Samsung
25 is saying that select does not mean tune or change the channel,

1 then they are trying to expand the scope of the claims beyond
2 the written claim language and import from the specification
3 certain language.

4 I think Mr. Green said that select means the same as
5 select for viewing. Select is to change the channel. That's
6 what we understand it to mean.

7 The addition of "and tuning," we just see as
8 redundant. The claims use select. And we add and select means
9 something different, they're trying to expand the -- expand the
10 scope of the language.

11 THE COURT: Well, the reason -- the reason I asked the
12 question was I heard him say you would select and not just
13 select but select for viewing. And I gathered there was a
14 distinction between select and select for viewing, which select
15 for viewing, I think he told me, meant the same thing as
16 tuning. I'm still not clear whether there is a select that is
17 not a select for viewing that is different from tuning. You
18 might address that.

19 MR. GORDON: Certainly.

20 So in the -- in Samsung's reply brief, they stated for
21 the first time that selection alone refers to, quote,
22 identifying a particular TV channel. Indeed, in certain
23 embodiments, channel objects are selected to build a customized
24 list without tuning to a channel. So it appears that Samsung's
25 position is that select on its own in the '043 patent, for

1 example, does not mean select for viewing or to change the
2 channel. We believe it does mean that, and that would be the
3 same as select for viewing in part because of the prosecution
4 history.

5 Mr. Green mentioned the -- the amendment over Miller.
6 The patent was initially rejected over Miller because the
7 Office Action said that, well, Miller does not disclose a
8 graphical channel changer and does not function to change the
9 channel, in response to which the patentee added the -- added
10 in the '333 patent, whereby said graphical changer -- channel
11 changer allows selection of desired TV program for viewing.

12 So to get around the concept that, you know, it
13 doesn't function to change the channel, they add the language,
14 "selection of a desired TV program for viewing." That may be
15 fine in the '043 patent -- that's selection of a TV program for
16 viewing means change the channel, but there's no reason to
17 import a separate redundant tuning element which would expand
18 the scope of the '043 -- '043 claim.

19 Briefly with respect to channel objects, Your Honor,
20 and I will try to go quickly. Mr. Green commented on how the
21 claim language must have channel objects. The '043 patent
22 doesn't mention channel objects in Claim 1. It does not
23 reference them. In fact, in Claim 2, it says -- it claims:
24 The system of Claim 1 wherein said regular and customized
25 channel changers comprise channel objects for enabling the user

1 to switch the TV channels by directing remote pointing --
2 pointing device at said channel object. Basic construct of
3 claim differentiation, Claim 2 includes the channel objects.
4 Claim 1 must be broader and cannot include the channel objects.

5 Now, Mr. Green might come up here and say, well, these
6 channel objects are for enabling the user to switch the TV
7 channels by directing the remote pointing devices at channel
8 objects. I've looked at the '043 patent, I can't think of how
9 many times now, and I don't see any other discussion of any
10 other way to change the channel in this patent other than by
11 pointing a remote device and selecting something and changing
12 the channels.

13 THE COURT: All right. What else?

14 MR. GORDON: That is it, Your Honor.

15 THE COURT: All right. Let me hear in response from
16 Samsung.

17 MR. GREEN: Thank you, Your Honor.

18 Very quickly, those -- those things that Mr. Gordon
19 said I'm going to say, I'm not going to say them. But I am
20 going to make two points in less than two minutes, and you can
21 hold me to it.

22 The first one is we saw on Slide 30 -- if I could have
23 it, Slide 30 of TiVo's presentation -- you're going to see a
24 lot of discussion of a patent from this family, not the two
25 patents in this lawsuit, but a patent from the same family

1 called the '781 patent that claims this facilitated transition.
2 And if we were construing this claim, then maybe we could talk
3 about a lot of the evidence that Mr. Gordon showed you, but
4 we're not. The claims of these patents are not directed to
5 facilitated transitions from a channel changer to a program
6 guide. The claims here pick up with the program guide or the
7 presence of the channel changers. There's no -- there are
8 other embodiments in the patents that describe that process of
9 growing a program guide out of a channel changer. That's not
10 what's claimed here.

11 If TiVo wants to attack our claims on some other
12 grounds because they don't -- they don't describe the
13 facilitated transition or whatever, they may do that. But for
14 claim construction, we should construe the claims according to
15 the language as it's written. This claim, the '781 patent
16 claim. Not what we have.

17 The second point I wanted to make, Your Honor, was to
18 hopefully directly and finally address your question about the
19 difference in selecting and tuning.

20 If I may have Slide 25 of Samsung's presentation.
21 That's it.

22 Tuning and selection. Tuning may happen in response
23 to selection. But selection can happen without tuning. Here's
24 an example. I know Your Honor and your staff are going to read
25 the patent carefully. You will see a description in both

1 specifications of building a channel changer where the user
2 gets to pick which channels. It's called like a favorites
3 list. I may have six or seven channels I want to watch, and
4 there's a description of this in very clear terms where I pick
5 the ABC channel, the Disney channel, the ESPN channels, and I
6 move them into a -- kind of a custom programming guide. I can
7 select those channel objects, and I can select those channels
8 for inclusion in my -- my custom well. But I haven't tuned any
9 of them yet. I'm just building a custom channel changer.

10 It's only when I go to viewing and wanting to see the
11 actual program, that's selection and tuning. And that's --
12 that's all there is, and there ain't no more, Your Honor.

13 Thank you.

14 THE COURT: So effectively, you're telling me there is
15 selection for gathering information?

16 MR. GREEN: That's correct.

17 THE COURT: And then there's selection for viewing?

18 MR. GREEN: That's correct. Selection and identifying
19 something for some purpose. For the specific purpose of
20 viewing, you have to tune. Thank you.

21 THE COURT: All right.

22 MR. GREEN: Thank you.

23 THE COURT: All right. Let's -- let's move on to
24 argument with regard to capable of displaying a user interface.
25 This is a Samsung term in dispute from their asserted patent,

1 the '592. Let me hear from Samsung on this term.

2 MR. GREEN: Thank you, again, Your Honor.

3 If I may have Slide No. 36.

4 Okay. Your Honor, we say no construction necessary.

5 It was very easy to write that part of the brief, no

6 construction necessary.

7 TiVo said: Possessing its own display capability
8 comprising a screen for display. And there's a new element
9 here that got added in reply called content for a user. So do
10 we have to have an embedded display screen, and do we need this
11 content to a user limitation? The answer to both questions
12 conveniently is -- is no.

13 So let's go right to it. Slide 38.

14 We see the plain language says: Capable of displaying
15 a user interface. Not a user interface, not a screen, not a
16 television monitor. It says, capable of displaying, plain
17 language, end of discussion, we think.

18 THE COURT: So what you're telling me is if a signal
19 is sent, whether anybody ever sees it or not, it's capable of
20 displaying?

21 MR. GREEN: Like a forest falling in the tree, Your
22 Honor -- or a tree falling in the forest. I just coined a
23 new -- yes. I'll stop there.

24 THE COURT: Okay.

25 MR. GREEN: You're exactly right.

1 THE COURT: I understand your position. I'm not
2 saying I agree with it, but I understand it.

3 MR. GREEN: Thank you.

4 Looking at the specification, we see examples of home
5 devices connected to a home network. And remember, this
6 capable of displaying function goes with home devices. We see
7 a direct broadcast satellite system 104. We see a digital
8 video device 108 and a digital video cassette recorder 110.
9 Those three things have one thing in common, and that one thing
10 is none of them have a monitor. They don't have an embedded
11 display.

12 We see them here in Figure 1, as shown on Slide No. --
13 Slide No. -- oh, my goodness, I can't read my slide numbers,
14 Slide No. 39.

15 No displays. We see more -- we really think -- we
16 think unequivocal disclosure from the specification, the
17 capabilities -- operative word "capabilities" of a digital
18 video cassette recorder generally include accepting video and
19 displaying video. I've not heard or not seen any contention
20 from TiVo that a DVC -- a digital video cassette recorder must
21 have a -- a monitor or does have a monitor.

22 What we do see when we read the specification is that
23 when the patentees meant to describe a device that had its own
24 screen, they used different language. So topmost excerpt on
25 this slide describes a DTV, a digital television, having a

1 viewable display. We see another reference to the digital
2 television as comprising a screen. And then the last reference
3 at the bottom of the slide, a video display of a client device,
4 such as a TV or a personal computer.

5 Again, a distinction, Your Honor, in the language used
6 when we mean to say has a display versus is capable of
7 displaying.

8 I'm going to skip ahead to the last point, Your Honor,
9 in the interest of time and address anything else that TiVo
10 wants to say on rebuttal.

11 The last part of the construction that TiVo put out
12 there, and, again, I think they did on it reply, was this --
13 adding this requirement of content to a user, and they did that
14 to get rid of a requirement for an HTML concept in the claim
15 construction.

16 So that's incorrect, and here's why. The
17 specification describes a user interface that allows command
18 and control of home devices. I don't know what content to a
19 user means. Content to a user could be a picture, it could be
20 some alphanumeric string. There's nothing that suggests
21 content to a user is going to allow command and control of home
22 devices.

23 And if we read the specification, we see the user
24 interface is to enable the user to control and command any
25 device. Each home device provides an interface for commanding

1 and controlling the home network. We never see this phrase
2 "content to a user" anywhere. It's not in the plain language
3 of the claims. It's logically inconsistent with the notion of
4 the controlling and command and control information. And,
5 therefore, it's incorrect.

6 I'll reserve the rest of the time for rebuttal, as
7 needed.

8 Thank you.

9 THE COURT: Let me hear from TiVo in response, please.

10 MR. GORDON: Thank you, Your Honor. I will try to be
11 brief.

12 With respect to capable of displaying a user -- a user
13 interface, I think you'll see here several of the same images
14 and some of the same language on our slides as you just saw on
15 Samsung's slides.

16 What I want to do first and briefly is just put this
17 into context. Claim 1 of the '592 patent in which this appears
18 describes the purpose of displaying of a user -- a home device
19 that is capable of displaying a user -- a user interface, and
20 that's to accept user input from a user by a presently
21 connected home device that is capable of displaying a user
22 interface.

23 And the patent distinguishes in this -- in this way
24 from home devices that are not so capable that have been
25 connected to the network and devices that are so capable that

1 have been connected to the network. And through this user
2 input, the patent then goes on to claim controlling home
3 devices based on that user input.

4 So on this brief graphic, you can have a network with
5 various home devices connected to it, but the user input goes
6 through one of those devices that is capable of displaying a
7 user interface. And it is so capable because that is how the
8 user can interact with it. It must have a screen to do so.

9 The specification consistently describes what it calls
10 client-facing devices having a display. Mr. Green put up
11 something very similar or perhaps identical to this Figure 1.
12 You can see on the right, the DTV, Item 102 with the arrows,
13 human interface, pointing to it. That's the -- the device that
14 is capable of displaying user interface. The DVD and the DVCR
15 on the left are not client facing. They're not -- they don't
16 have a human interface.

17 So in various language from the specification, the
18 user interacts with home devices, you know, on its -- on those
19 devices' viewable -- viewable display. On the bottom, the DTV,
20 because it has a screen, can provide the human interface for
21 the home network as it comprises a screen for displaying HTML
22 pages. We no longer say that's a limitation of the claim.

23 But what is correct is that only some devices are
24 capable of displaying an interface. And the patent
25 consistently discusses those in the sense that they have a

1 viewable display or a screen.

2 THE COURT: In other words, what you're telling me is
3 Samsung wants me to read this phrase in isolation, but when I
4 read it as modifying the term "device," then capable -- a
5 device capable of displaying needs a screen, but capable of
6 displaying by itself may mean merely capable but not actually
7 displaying. Is that the distinction?

8 MR. GORDON: So I don't think that's quite the
9 distinction, Your Honor.

10 THE COURT: All right.

11 MR. GORDON: I think the patent discusses numerous
12 devices that are capable of projecting information, sending
13 information to be displayed, such as a DVD player or a DCVR on
14 this -- this slide here. Those -- that -- that content, and
15 we'll talk about content in a second, but that -- those
16 devices are accessed and controlled in the context of this
17 patent through the device that has a screen, through the
18 device that is, quote, capable of displaying user interface,
19 because that is how the user interacts with all of the devices
20 as the patent is constructed. And this is not just the
21 specification.

22 Again, this patent claims priority to provisional
23 application, and in this provisional application, again, they
24 have this same setup, client and server. And the client
25 devices -- it says here it here in the middle of the screen --

1 show content to users. Internet DTV is a good example of a
2 client device. The user capable of displaying user interface
3 because they're client based, and they have a screen.

4 The inventor said, what is display capable? It's a
5 client display device. What is a server device? That's not a
6 display device. No listing of display capable. It might have
7 a GUI. It might have some information that is able to -- to be
8 displayed, but it doesn't have a display itself.

9 Again, the same thing. At the bottom, the HDVCR is a
10 server device, capable of transmitting content, transmitting an
11 A/V stream. This is what Mr. Green pointed to in the
12 specification where this is the same thing, a DVCR that's
13 capable of displaying video.

14 What they meant in the provisional application in
15 which this claims priority is that that information is
16 displayed to the user through a -- a device with a screen.

17 And I just briefly want to mention one thing in the
18 prosecution history, Your Honor, because I think it's
19 important. In the prosecution history, the patent was
20 initially rejected over this Suzuki reference in which various
21 robots could send data and images to a user who could see what
22 was happening with those robots, through a computer, through a
23 screen. They could be -- the robots could be monitored and
24 operated remotely by a web-based display, but the robots were
25 sending information that could be seen on that display.

1 There's an image of what the robot could send, pictures, data,
2 et cetera.

3 Samsung, during construct -- during prosecution said,
4 indeed, Suzuki does not disclose that a robot displays a
5 user -- user interface for receiving user input. And that's
6 because it was not how the user was interacting with the robot.
7 It was capable of sending that information to be displayed, but
8 it itself did not have that user interface.

9 And for that reason, the patentees argued that Suzuki
10 did not disclose a home device that's capable of displaying a
11 user interface.

12 Now, other things were at issue in this -- in this
13 rejection. There were issues of control. There were issues of
14 what type of home device this was, but this was absolutely at
15 issue, that Samsung said, indeed, Suzuki does not disclose that
16 a robot displays a user interface first for receiving inputs.
17 That is one way in which they distinguished the robots in
18 Suzuki from the claims of their patent.

19 And that's all I have, Your Honor.

20 THE COURT: All right. Thank you. Let me have a
21 response from Samsung.

22 MR. GREEN: Thank you, Your Honor.

23 Very quickly. There's a lot of talk about client and
24 server in the briefing, and a lot of client and server
25 discussion in the presentation you just saw, but one place

1 you'll never see the words "client" and "server" are -- is in
2 the claims to be construed. It's not there.

3 So I believe TiVo has improperly borrowed something
4 from a provisional application, a particularized embodiment,
5 contorted the words a little bit, and then tried to rewrite
6 the claims into what is described in the provisional. And we
7 all know that's not how you conduct claim construction. It's
8 not there. Our papers are sufficient on this. I'm going to
9 have my fingers crossed when I say that, so I'm going to leave
10 it there.

11 On the Suzuki point, the robots, they look pretty
12 cool. I think my 10 and 8-year-old would really like remote
13 controlled robots that take pictures and move around the room.

14 THE COURT: Is that relevant?

15 MR. GREEN: Well, what I'm going to say is they take
16 pictures, and that's what they do. They can't control each
17 other. It may be an interesting thing to talk about, but
18 that's it. They don't -- they're not home devices. They are
19 not -- they're not -- they were distinguished on multiple
20 grounds, not solely on the basis of lacking the capability of a
21 display.

22 TiVo has stitched together unrelated parts of that
23 prosecution discussion, Your Honor and your staff will not see
24 clear disclaimer saying those robots are not home devices
25 simply because they don't have the capability of displaying.

1 And that's my point, Your Honor.

2 THE COURT: All right. All right, counsel. Thank
3 you.

4 MR. GREEN: Thank you.

5 THE COURT: That will complete argument on the five
6 identified terms for argument this afternoon. The remaining
7 terms in dispute, the Court will consider based on the
8 extensive briefing that I have before me.

9 I'll endeavor, counsel, to get you written guidance by
10 way of a claim construction opinion as time will permit.

11 You're aware, I know, that it's the Court's practice
12 and custom to require that you mediate within 30 days of the
13 issuance of a claim construction order.

14 I expect it will take me, given the scope and the
15 breadth of what's here, not only what's been argued today but
16 what's not been argued, I expect it take several weeks to get
17 you a claim construction order, but I will do my best to get it
18 out as promptly as permitted.

19 Are there questions from either side before we recess
20 for the day?

21 Anything further from Plaintiff.

22 MR. CHU: No, Your Honor.

23 THE COURT: Anything further from Defendants?

24 MR. CORDELL: No, Your Honor. Thank you.

25 THE COURT: That completes today's claim construction

1 hearing, counsel. Thank you for your argument and attendance.

2 You're excused.

3 COURT SECURITY OFFICER: All rise.

4 (Hearing concluded.)

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CERTIFICATION

I HEREBY CERTIFY that the foregoing is a true and correct transcript from the stenographic notes of the proceedings in the above-entitled matter to the best of my ability.

/S/ Shelly Holmes
SHELLY HOLMES, CSR-TCRR
OFFICIAL REPORTER
State of Texas No.: 7804
Expiration Date: 12/31/16

11/1/16
Date